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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194974
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PROMARK BRANDS INC. and
H. J. HEINZ COMPANY,

Opposers,

vs.

GFA BRANDS, INC.,

Applicant.

**Opposition No. 91194974 (Parent)
and Opposition No. 91196358**

U.S. Trademark Application 77/864,305
For the Mark **SMART BALANCE**

U.S. Trademark Application 77/864,268
For the Mark **SMART BALANCE**

OPPOSERS' REPLY BRIEF

PUBLIC VERSION –

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I. INTRODUCTION

Throughout its untimely-filed Trial Brief,¹ Applicant repeatedly contends that its SMART BALANCE products have coexisted with Heinz's SMART ONES products since it began offering a butter substitute product under the mark SMART BALANCE in 1996. The reason the parties' respective products have coexisted to date is very simple (although completely ignored by Applicant)—*Heinz and Applicant do not sell products in the same product categories.*

Applicant now intends to disrupt the parties' historically peaceful coexistence, by seeking to register its SMART BALANCE mark for use in connection with frozen appetizers and entrees (Ser. No. 77/864,305, "the '305 Application") and for use in connection with various snack foods and desserts, including frozen cakes (Ser. No. 77/864,268, "the '268 Application"). As set forth in Heinz's Trial Brief, Heinz has opposed Applicant's applications because they will unquestionably damage the distinctiveness and impair the value of Heinz's SMART ONES mark, which was registered and used by Heinz for identical goods long before Applicant filed the applications at issue and long before Applicant's first use of its SMART BALANCE mark.

¹In yet another instance of Applicant's disregard for the rules governing this proceeding, Applicant's 55-page Trial Brief was submitted six days late. Notwithstanding Applicant's continued failures to adhere to the Rules, Heinz has assiduously met all deadlines set by the Board in this proceeding, including the deadline originally set by the Board for the filing of this Reply Brief. Although it has caused Heinz considerable difficulty to prepare this Reply Brief in a significantly shorter amount of time than it is entitled to under the rules, Heinz and its counsel have diligently met the deadline. Of course, when one party scrupulously adheres to the rules and the other does not, the prejudice to the conforming party is manifest.

Should the Board grant Heinz's Motion to Strike Applicant's Trial Brief (TTABVue Doc. No. 94), the Board need not consider this submission. *See* TBMP § 801.02(c) ("[I]f the defendant has not filed a main brief, any reply brief filed by the plaintiff may not be considered because there is nothing to which it could reply."). However, in the event Applicant's Trial Brief is not stricken, Heinz hereby submits its Reply Brief.

Applicant's Trial Brief misses the point entirely. Through the '305 Application and the '268 Application, Applicant is not merely attempting to "add one more" SMART BALANCE product into the mix of "SMART-branded" food products. Rather, Applicant endeavors to offer *the first* "SMART-branded" products other than Heinz's SMART ONES products in the frozen foods category, a category in which Heinz is entitled to exclusive use of the SMART ONES mark.

Heinz's SMART ONES products consist of various types of frozen foods, including entrees, desserts, ready-to-eat wraps, pizzas, and breakfast foods. Although Applicant offers several products under its SMART BALANCE mark,^{2, 3} Applicant does not currently offer any frozen food products. In fact, the record establishes that Heinz is the only company that currently offers and sells what Applicant refers to as a "SMART-branded" food, in the frozen foods product category.

In response to Heinz's arguments that registration of Applicant's SMART BALANCE mark as set forth in the applications at issue is likely to cause confusion among consumers, Applicant concedes that many of the *du Pont* factors favor Heinz. Specifically, Applicant admits that it uses the "same advertising methods, promotional channels and even sell[s] product in the exact same stores" as Heinz. (App. Br. at 6.) Indeed, if Applicant were permitted to register its SMART BALANCE mark for frozen foods, there is no dispute between the parties that its products would be advertised using the same methods, in the same promotional channels, and

² Applicant's current SMART BALANCE products include butter substitutes, cooking oil, milk, popcorn, peanut butter, mayonnaise, eggs, and sour cream. (TTABVUE Doc. No. 92 "App. Br." at 5.)

³ The list of SMART BALANCE registrations in Applicant's Trial Brief (App. Br. at 5) is misleading in that Applicant fails to mention that some of the goods in Registration Nos. 2,200,663 and 2,276,285 have been cancelled from those registrations.

would be sold to the exact same retailers as Heinz's SMART ONES products. Moreover, Applicant's proposed SMART BALANCE frozen foods would be sold in the same freezer cases as Heinz's SMART ONES products and would simultaneously be viewed by the same customers purchasing Heinz's SMART ONES products. The fact that the parties use the same advertising methods, that they use the same promotional channels, and that they sell their respective goods to the exact same stores fully supports the conclusion that the parties' marks are likely to be confused in the marketplace, particularly when the two marks are used for identical goods.

The only *du Pont* factors contested by Applicant are the similarity of the marks, the degree of care exercised by consumers, and the number and nature of similar marks in use on similar goods. Applicant also asks the Board to consider the lack of actual confusion between the parties' marks on different products than those at issue and the fact that Applicant no longer heavily enforces its own marks. However, none of the contested *du Pont* factors weigh in Applicant's favor and neither of the foregoing considerations affects the conclusion that confusion between the SMART ONES and SMART BALANCE marks for identical goods, sold in the identical channels of trade to the same retailers and to the same ultimate consumers, is likely. Accordingly, this consolidated opposition should be sustained and Applicant's applications to register the mark SMART BALANCE as shown in Application Serial Nos. 77/864,305 and 77/864,268 should be refused under Sections 2(d) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1125(c).

II. EVIDENTIARY MATTERS

A. Description of the Record

Heinz notes that Applicant omitted from its description of the record the certified transcripts of the testimonial depositions of Heinz witnesses Sabrina J. Hudson, Esq., Mr. Eric

Michael Gray, and Barry A. Sabol, Ph.D. To be sure, these transcripts are part of the evidence of record in this proceeding. See TBMP § 703.01(l) (“All trial testimony depositions . . . automatically constitute part of the evidentiary record in the proceeding.”).

B. Evidentiary Objections

Heinz’s Reply in support of its evidentiary objections to certain testimony and exhibits offered by Applicant is attached hereto as Appendix A.

III. ARGUMENT

A. The Contested and Uncontested *du Pont* Factors

1. Factor Nos. 1 and 2: The Two Key Considerations In The Likelihood of Confusion Analysis

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods.” *Edom Labs., Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1549 (T.T.A.B. 2012). Glaringly absent from Applicant’s submission is any analysis of one of these two “key considerations”: *the similarities between the parties’ respective goods*. However, Applicant cannot ignore the fact that the goods claimed in the applications at issue are **identical** to those claimed in Heinz’s prior SMART ONES registrations.

(a) The Parties’ Goods Are Identical

There is no escaping the fact that the goods for which Applicant seeks to register the mark SMART BALANCE in the ‘305 Application (i.e., “frozen appetizers primarily containing poultry, meat, seafood or vegetables; frozen entrees primarily containing poultry, meat, seafood or vegetables”; and “frozen entrees consisting primarily of pasta or rice”) are identical to the goods protected by U.S. Registration No. 1,911,590 for the mark SMART ONES, which is owned by Heinz. Likewise, the goods for which Applicant seeks to register the mark SMART BALANCE in the ‘268 Application (i.e., “frozen cakes” and other snack foods) are identical, in

part, to the goods protected by U.S. Registration No. 2,916,539 for the mark SMART ONES, which is owned by Heinz. “[L]ikelihood of confusion may be found based on any item that comes within the identification of goods in the involved application and registration.” *In re La Pelegrina Ltd.*, 86 U.S.P.Q.2d 1645, 1646 (T.T.A.B. 2008) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 26 U.S.P.Q.2d 1687 (Fed. Cir. 1993)). A likelihood of confusion as to any one of the products claimed in Applicant’s applications is “sufficient to support a conclusion that the opposition should be sustained.” *Edom Labs.*, 102 U.S.P.Q.2d at 1550.

Significantly, Applicant cannot (and indeed does not) dispute that the goods claimed in the applications at issue are identical or closely related to the goods for which Heinz’s SMART ONES mark are registered. In view of the identical nature and obvious overlap in the goods claimed in the ‘305 Application and the ‘268 Application with Heinz’s prior registrations, this consideration unequivocally and heavily weighs in favor of a finding of likelihood of confusion.

(b) The Parties’ Marks Are Similar In Sight, Sound, And Meaning

Applicant also cannot ignore “the well-established principle that where goods or services are identical and travel through the same channels of trade to the same class of end users, the degree of similarity of marks is less than that otherwise required in situations where the goods or services are dissimilar or noncompeting.” *Humana Inc. v. Humanomics Inc.*, 3 U.S.P.Q.2d 1696, 1700 (T.T.A.B. 1987); accord *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 U.S.P.Q.2d 1257, 1260 (Fed. Cir. 2010). Given that Applicant is seeking to register the mark SMART BALANCE for frozen entrees, frozen appetizers, and frozen cakes—the same goods covered by Heinz’s prior SMART ONES registrations—and given that those goods travel through the same channels of trade and to the same end users as Heinz’s SMART ONES goods, a lesser degree of similarity between the marks is required to find a likelihood of confusion.

It is also well-established that consideration of the similarities between two marks does not involve a side-by-side comparison. *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1975). Instead, the focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Id.* To the average purchaser, “the points of similarity between two marks are more important than minor points of difference.” 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:41 (4th ed. 2009) (hereinafter “McCarthy”).

Taken as a whole, the similarities between Applicant’s SMART BALANCE mark and Heinz’s SMART ONES mark provide more than ample grounds upon which to conclude that consumer confusion is likely. Specifically, the first element of the parties’ marks is identical: Applicant’s mark, like Heinz’s SMART ONES mark, begins with “SMART.” Applicant’s mark, like Heinz’s SMART ONES mark, is also a standard character mark (i.e., neither include any design elements). And Applicant’s mark, like Heinz’s SMART ONES mark, consists of two words. Further, Applicant’s mark, like Heinz’s SMART ONES mark, connotes health conscious products. In addition, at least two witnesses, Mr. Gray (who talks to retailers and customers as part of his job responsibilities) and Ms. Hudson (an experienced trademark attorney), affirmatively testified that they consider the SMART ONES mark and the SMART BALANCE mark to be similar in terms of overall appearance, sound, meaning, and commercial impression.⁴ (Gray Tr. 27:12-28:10; Hudson Tr. 15:6-16:7.) Applicant cannot, and in fact does not, suggest that this testimony is in any way incorrect, untruthful, or not probative.

⁴ Of course, a finding of similarity in any one of these respects is sufficient to support a determination that there is a likelihood of confusion. *In re White Swan, Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988).

Ms. Findlay's off-the-cuff remark that "smart" is generally a "laudatory or complimentary term" (Findlay Tr. 68:18-21) does not affect the conclusion that the SMART ONES and SMART BALANCE marks are confusingly similar in their entireties. First, in her deposition, Ms. Findlay expressed confusion about the meaning of the word "laudatory" and, in response, was prompted by Applicant's counsel that the word "smart" in connection with food products "is better than 'dumb.'" (Findlay Tr. 73:18-74:5.) Obviously, this is not an accurate definition or explanation of what is meant by the word "laudatory" in trademark law. Second, the registrations of record do not support that "SMART" is a laudatory term as used in Heinz's SMART ONES mark because no disclaimer has ever been required for any of Heinz's SMART ONES registrations or applications.⁵

More importantly, there is no dispute that Heinz has used its SMART ONES mark for frozen food products for more than 20 years, and has made extensive sales and expended substantial sums in promoting its SMART ONES products. Even if the Board were to find that the term SMART in Heinz's mark had a descriptive connotation when it was first adopted (which it did not), the Board must nonetheless regard it as a strong mark after 20 years of continuous, exclusive, consistent, and uncontested use by Heinz as a trademark for its frozen foods. *See Kellogg Company v. Dorothy Cullars Waugh*, Opp. No. 91113611, 2002 WL 31269786, at * 4 (T.T.A.B. Oct. 9, 2002) (rejecting a similar argument raised by the applicant and sustaining Kellogg's opposition to the mark SUPER START for cereals in view of Kellogg's

⁵ See U.S. Trademark Reg. Nos. 1,911,590, 2,204,080, 2,916,538, 2,916,539, and 3,462,182; *see also* U.S. Trademark Ser. No. 85/886,703, which was published on August 13, 2013. "Laudatory terms, those that attribute quality or excellence to goods or services, are merely descriptive under §2(e)(1)." TMEP § 1209.03(k). In general, the Trademark Office requires a disclaimer of merely descriptive matter as an unregistrable component of a registrable mark. TMEP § 1213.03(a).

prior registration for the mark SMART START for identical goods); *see also Presto Products Inc. v. Nice-Pak Products Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) (finding that purchasers would likely be confused between KIDWIPES and KID STUFF for identical goods).

In sum, the record clearly shows that the parties' goods are identical, that they are advertised in the same manner and even in the exact same channels, that they are sold to the exact same stores, that they are sold to the exact same end consumers, and that the marks used to promote those goods are similar in appearance, sound, meaning, and commercial impression. At a minimum, both of the "key considerations" in the likelihood of confusion analysis weigh heavily in favor of Heinz.

2. *Factor No. 4: Customers Purchasing Frozen Foods Do Not Exercise "Considerable Care"*

The fourth *du Pont* factor requires consideration of "[t]he conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The Board has repeatedly recognized that consumers generally do not exercise a high degree of care in purchasing relatively low-cost goods. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 U.S.P.Q. 1281, 1282 (Fed. Cir. 1984) (finding that purchasers of inexpensive, comestible goods subject to frequent replacement have been held to a lesser standard of purchasing care); *Nike, Inc. v. WBNA Enterprises, LLC*, 85 U.S.P.Q.2d 1187, 1196 (T.T.A.B. 2007) (holding goods in the range of \$15-\$100 were "relatively inexpensive" such that "[i]t is unlikely that these products would be purchased with the exercise of a great deal of care").

Applicant does not dispute that the products at issue in this proceeding are relatively inexpensive—normally selling in the range of \$2.00-\$4.00. (TTABVUE Doc. No. 82 "Heinz

Br.” at 28, citing Gray Tr. 33:13-20, 34:11-13.) Rather, Applicant relies on Ms. Findlay’s testimony that frozen nutritional products are not bought on impulse and Ms. Hudson’s testimony confirming that Heinz’s SMART ONES products are considered frozen nutritional products to argue that customers of frozen foods exercise “considerable care.”

To be sure, the purchase of frozen foods from the grocery store is not an impulse purchase in the same way that a chocolate bar or a pack of chewing gum tossed in one’s cart in the checkout line are impulse purchases. But that does not mean that purchasers of frozen foods, even frozen nutritional meals, exercise “considerable care.” The purchase of frozen foods from the grocery store certainly does not involve the same careful, sophisticated purchasing as would, for example, the purchase of an automobile, of medical devices, or of building materials. Indeed, in the overall scheme of things, the Board and the courts have repeatedly recognized that “[p]urchasers of relatively inexpensive goods such as ordinary grocery store foods are held to a lesser standard of purchasing care.” McCarthy § 23:95 (citing *Specialty Brands*, 748 F.2d 669, 223 U.S.P.Q. 1281 and *General Mills, Inc. v. Fage Dairy Processing Industry S.A.*, 100 U.S.P.Q.2d 1584, 1600 (T.T.A.B. 2011), among other similar decisions). Moreover, even if some consumers of frozen foods scrutinize the nutritional value of those meals, this does not mean that they are attendant to the relevant trademarks and capable of discerning distinctions between them. *See In re Research & Trading Corp.*, 793 F.2d 1276, 1279, 230 U.S.P.Q. 49, 50 (Fed. Cir. 1986).

Furthermore, both Heinz’s frozen food products and Applicant’s proposed frozen food products would be offered and sold not only to health conscious consumers, but to the public at large. So even assuming “some of the parties’ more health-conscious consumers may be more careful in their purchase, [the Board] must base [its] decision on the least sophisticated potential

purchasers.” *General Mills*, 100 U.S.P.Q.2d at 1600; *see also Alfacell Corp. v. Anticancer Inc.*, 71 U.S.P.Q.2d 1301, 1306 (T.T.A.B. 2004) (holding that the standard of care to be exercised is “equal to that of the least sophisticated consumer in the class”). Here, the least sophisticated potential purchasers would be members of the public at large who exercise a low degree of care when purchasing frozen foods from an ordinary grocery store.

As set forth in Heinz’s Trial Brief, given the low degree of care and the relatively low price of the goods, this factor supports a finding of likelihood of confusion.

3. *Factor No. 6: The Alleged Third Party Uses Identified By Applicant Are Probative of Nothing*

Applicant relies heavily and devotes much of its Trial Brief to purported third party use of “Smart” marks. The sixth *du Pont* factor, however, requires consideration of “[t]he number and nature of *similar marks* in use *on similar goods*.” *Du Pont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567 (emphasis added). Third party uses of dissimilar marks on dissimilar goods have no relevance. *See World Triathlon Corp. v. Traditional Medicinals, Inc.*, Opp. No. 91110391, 2008 WL 4876562, at *7 (T.T.A.B. Nov. 3, 2008) (rejecting alleged evidence of “widespread third-party use” because “most of these third-party registrations are for goods and services that are far removed from the goods at issue herein”); *Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579, 19 U.S.P.Q.2d 1424, 1429-30 (Fed. Cir. 1991) (finding that alleged evidence of third party use is outside of the relevant field “is not only unpersuasive but essentially meaningless”); *see also Safeway Stores, Inc. v. Safeway Disc. Drugs, Inc.*, 675 F.2d 1160, 1165, 216 U.S.P.Q. 599, 603 (11th Cir. 1982) (holding that the “entire name a third party uses” is relevant in determining the significance of third party use). Moreover, third party uses are not entitled to any weight without probative evidence demonstrating the nature and extent of use, actual sales, whether or to what extent consumers are aware of them, and so on. *See AMF*,

Inc. v. Am. Leisure Prods., Inc., 474 F.2d 1403, 1406, 177 U.S.P.Q. 268, 270 (C.C.P.A. 1973) (rejecting proffered listing of third party trademarks because it “give[s] no indication as to actual sales, when the mark was adopted, customer familiarity with the marks, etc.”); *Jansen Enters. v. Rind*, 85 U.S.P.Q.2d 1104, 1110 (T.T.A.B. 2007) (“[T]here is neither testimony nor other evidence corroborating these [purported third party uses] . . . [and] there is no way to know what effect, if any, these purported uses . . . may have had in the minds of consumers.”).

Not a single one of the alleged third party uses or registrations identified by Applicant in its submission shows use of a “SMART” mark on any goods covered by any of Heinz’s SMART ONES registrations.⁶ Furthermore, there is no evidence showing the extent of the public’s exposure to the alleged uses, i.e., there is no evidence that the marks are in use on a commercial scale, or that the public is even aware of them.

As to the alleged third party use of marks incorporating the term SMART for grocery products, Mr. Shanks’ testimony establishes only that an investigation was conducted and that photos of certain products were taken by an independent contractor and an independent investigative firm. (*See Shanks Tr.* 29:7-30:6, 9:6-15, 19:25-20:14.) Neither the independent contractor nor the independent investigative firm offered any testimony in this proceeding. Furthermore, Mr. Shanks was unable to testify as to the geographic scope in which the photographed products are sold, the volume sold of such products, the length of time such

⁶ With respect to the BREYERS CARBSMART ice cream bar product referenced in Applicant’s Trial Brief, Heinz notes that CARBSMART appears to be used by Breyers as a secondary mark and that the mark is a compound word mark (not a two word mark) that does not begin with the term “SMART.” Accordingly, Heinz submits that the BREYERS CARBSMART mark is not a similar mark to SMART ONES. Furthermore, there is no evidence that Breyers offers anything other than ice cream bars under the BREYERS CARBSMART mark and, even so, there is no evidence of the extent of the public’s exposure to the apparently limited use of the mark.

products have been on the market, the annual advertising expenditures for such products, or the degree to which the public is aware of such products. (*See id.* at 52:10-54:25.)

As to the third party printed publications (i.e., cookbooks, recipe books, and nutritional books) that include the word “smart” in their titles, as Heinz noted in its Trial Brief, these are not trademark uses. The title of a single creative work, namely, the title of a specific book, does not function as a trademark to identify and distinguish goods and to indicate their source. 15 U.S.C. §§ 1051, 1052, and 1127; *see In re Cooper*, 254 F.2d 611, 117 U.S.P.Q. 396 (C.C.P.A. 1958); *In re Scholastic Inc.*, 23 U.S.P.Q.2d 1774, 1777-78 (T.T.A.B. 1992); TMEP §1202.08.

“The probative value of third-party trademarks depends entirely upon their usage.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). Because there is no such evidence in the record to establish the public’s familiarity with the alleged third party uses and registrations, those alleged uses and registrations are probative of exactly nothing. The truth of the matter is that Heinz’s use of the SMART ONES mark is exclusive for the goods for which it is registered. Heinz has vigorously protected its rights in the SMART ONES mark on frozen food products and the lack of any such third party use confirms the strength of the SMART ONES mark.

Because there is no evidence of any federal trademark registrations for similar marks on frozen foods or evidence of any third party usage of similar marks for frozen foods, the sixth *du Pont* factor weighs in favor of Heinz.

4. *Factor Nos. 7 and 8: The Lack Of Actual Confusion Is Unsurprising Given That Applicant Has Not Yet Used The SMART BALANCE Mark For The Proposed Goods*

Applicant’s argument that the seventh and eighth *du Pont* factors strongly favor Applicant is disingenuous at best. The seventh *du Pont* factor calls for consideration of “[t]he nature and extent of any actual confusion” and the eighth *du Pont* factor calls for consideration

of “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *Du Pont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Applicant claims that the lack of actual confusion causes both of these *du Pont* factors to favor Applicant. However, neither factor is relevant to the issues in this proceeding.

There has not yet been any actual confusion between Heinz’s SMART ONES frozen food products and Applicant’s SMART BALANCE frozen food products because ***Applicant does not currently offer any SMART BALANCE frozen food products.***⁷ Thus, there has been no opportunity for confusion to occur, making both of these factors irrelevant. *See Gillette Canada Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (T.T.A.B. 1992) (“[T]he absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by applicant of its mark for a significant period of time . . .”). Moreover, it is well-settled that “lack of evidence of actual confusion carries little weight” in a *likelihood* of confusion analysis. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317, 65 U.S.P.Q.2d 1201, 1205 (Fed. Cir. 2003); *see also Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267, 62 U.S.P.Q.2d 1001, 1005 (Fed. Cir. 2002) (“A case involving an ITU application, where the disputed mark has not yet appeared in the marketplace, makes this point even more pertinent.”). This is particularly so where, as here, each of the relevant *du Pont* factors weighs in favor of a finding of likelihood of confusion.

5. *Factor No. 13: Applicant’s Enforcement Strategy*

As set forth in Heinz’s Trial Brief, Heinz submits that that Applicant’s enforcement strategy as to its SMART BALANCE marks is highly probative, and essentially an admission, of

⁷ Indeed, Heinz does not even consider Applicant to be a competitor currently because Applicant does not sell any products in the same product categories as Heinz. (Hudson Tr. 17:22-25; Gray Tr. 9:8-12.)

a likelihood of confusion and dilution between Heinz's SMART ONES mark and Applicant's SMART BALANCE mark for directly overlapping goods. In response, Applicant argues that it has changed its internal enforcement guidelines, such that it now enforces its rights only against third parties using "the term 'Smart' . . . coupled with a word that begins with 'B'" when those marks are used "for similar categories of goods." (App. Br. at 31.) Applicant further argues that its decision to allow third parties to enter into its market space using a SMART-formative mark is somehow evidence that Heinz's SMART ONES mark has become weak. Such wishful thinking on Applicant's part does not make it so. Indeed, Applicant's argument is belied by the evidence of record, which establishes that Heinz actively polices its SMART ONES mark against third party uses and that its efforts to date have been successful. To be sure, there are no third parties in the market today in the frozen foods category using marks that are at all similar to Heinz's SMART ONES mark.

6. *Factors 3, 5, and 12: The Uncontested Factors*

Heinz submitted in its Trial Brief that the third, fifth, and twelfth *du Pont* factors all favor Heinz. Inasmuch as Applicant has explicitly conceded or failed to address these factors in its brief, they appear to be uncontested by Applicant.

The third factor calls for consideration of "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." *Du Pont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Applicant has conceded that the parties' trade channels are identical. (*See, e.g.*, App. Br. at 6.)

The fifth factor calls for consideration of "[t]he fame of the prior mark (sales, advertising, length of use)." *Du Pont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Applicant does not seriously dispute that Heinz's SMART ONES mark are famous for purposes of the likelihood of confusion analysis, nor could it. From Fiscal Year 2007 to Fiscal Year 2011, SMART ONES products had

a net sales value of no less than [REDACTED]. (Gray Conf. Tr. 38:8-40:10 and Ex. 39.) Heinz's advertising and marketing expenditures for the SMART ONES brand totaled [REDACTED] [REDACTED] from Fiscal Year 2008 to Fiscal Year 2011. (*Id.* at 41-48 and Ex. 40.) And Heinz has consistently and prominently used the SMART ONES mark for more than 20 years. In fact, Applicant's own in-house counsel admitted that SMART ONES is a well-known brand. (Kraft Tr. 26:16-20.)

The twelfth factor calls for consideration of "[t]he extent of potential confusion, i.e., whether *de minimis* or substantial." *Du Pont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Heinz submitted in its Trial Brief that the potential likelihood of confusion between the SMART ONES and SMART BALANCE marks for frozen meals is substantial. This assertion appears to be uncontested by Applicant.

7. *Analysis Of The Relevant Factors Establishes That Confusion Is Likely*

Heinz has met its burden of establishing a likelihood of confusion between Heinz's SMART ONES mark and Applicant's SMART BALANCE mark as set forth in the applications at issue. Applicant's efforts to rebut Heinz's showing are unavailing. Applicant has failed to put forward sufficient evidence or argument demonstrating why its SMART BALANCE mark for frozen entrees, frozen appetizers, frozen cakes, and related goods should proceed to registration given Heinz's earlier-filed and famous marks for the identical goods. As the newcomer to the frozen foods category, Applicant has an obligation to avoid confusion with established marks. *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1333, 102 U.S.P.Q.2d 1061, 1063 (Fed. Cir. 2012). To the extent there is any doubt as to whether confusion, mistake, or deception is likely, such doubt must be resolved against Applicant. (*Id.*); *see also Hewlett-*

Packard, 281 F.3d at 1265, 62 U.S.P.Q.2d at 1003; *Broderick & Bascom Rope Co. v. Goodyear Tire & Rubber Co.*, 531 F.2d 1068, 1070, 189 U.S.P.Q. 412, 413 (C.C.P.A. 1976).

B. The Expert Testimony And Survey Evidence

Applicant argues that the survey performed by Heinz's expert, Dr. Barry A. Sabol, should be given little if any weight. On the other hand, Applicant asserts that the survey performed by Applicant's expert, Philip Johnson, should be given considerable weight.

As set forth in the Evidentiary Objections accompanying Heinz's Trial Brief, Heinz submits that Mr. Johnson's survey and his testimony should be stricken by the Board and disregarded in its entirety. Heinz disputes that the survey conducted by Mr. Johnson is a proper rebuttal survey. To the extent Mr. Johnson's survey was designed to support Applicant's case-in-chief (as opposed to rebutting the validity or probative value of the survey conducted by Dr. Sabol), Applicant failed to meet its obligations in timely disclosing Mr. Johnson as an expert.

Significantly, to the extent Mr. Johnson's survey evidence and testimony is admitted to *rebut* Dr. Sabol's expert report, Mr. Johnson's survey evidence and testimony can only be considered for that purpose, and not for purposes of supporting Applicant's case-in-chief. *See Bridgestone Firestone N. Am. Tire, LLC v. Fed. Corp.*, Opp. No. 91168556, 2010 WL 985350, at *2 (T.T.A.B. Feb. 24, 2010), *rev'd* 673 F.3d 1330 (Fed. Cir. 2012). Accordingly, if Heinz's expert evidence and testimony is not afforded any weight in the Board's analysis (as Applicant has asserted), the Board should not afford Applicant's rebuttal expert evidence and testimony any weight either. That is, if Dr. Sabol's survey and testimony is afforded no weight, there is nothing for Mr. Johnson, or Dr. Kaplan, to rebut.

As to the survey conducted by Dr. Sabol, Dr. Sabol was retained by Heinz to develop and conduct a survey to determine whether and to what extent consumers are likely to be confused by

Applicant's intended use of the mark SMART BALANCE for frozen meals. (*See* Sabol Tr. 10:23-12:15 and Ex. 1.) Dr. Sabol earned a Ph.D. in psychology, and his major field of study for his Ph.D. was research, design, and quantitative analysis. (*Id.* at 5:22-6:16.) Since completing his doctoral studies in 1978, Dr. Sabol's career has focused on market research, including advertising effectiveness research, customer behavior studies, customer satisfaction studies, brand awareness and equity studies, and brand loyalty studies. (*Id.* at 6:17-10:14.) The likelihood of confusion survey conducted by Dr. Sabol in this proceeding revealed that, upon encountering a brand of frozen meals bearing the SMART BALANCE mark, 32% of relevant consumers would mistakenly believe that the SMART BALANCE brand was associated with, licensed by, owned by, or in some other way connected to SMART ONES. (*Id.* at 28:11-29:24 and Ex. 1 at 12-13.)

Dr. Sabol's survey utilized a national (lower 48 states) replicate random sampling plan. (Sabol Tr. Ex. 1 at 3.) Replicate random telephone samples, including both landline and cell phone numbers, were purchased from Survey Sampling, LLC, the premier sample generator firm in the United States. (*Id.*)

Qualified respondents were persons who: (1) had personally purchased any frozen meals from the frozen food section of a supermarket in the past 30 days and (2) possessed at least nominal awareness of Smart Ones frozen meals. (*Id.* at 2.)

Once qualified, respondents were asked: (1) which of a list of six brands of frozen meals they have ever purchased; (2) if they were to see a brand of frozen meals in the frozen food section of a supermarket named Smart Balance, would they think it was associated with, licensed by, owned by or in any way connected to Smart Ones (and instructed that they may answer yes, no, or don't know); (3) which brand of frozen meals they purchase most often; and (4) how many

packages of frozen meals of any brand they have purchased from the frozen food section of a supermarket in the past month. (*Id.* at 17.)

The studies were administered under double-blind conditions: neither the interviewers nor the respondents were informed of the purpose or sponsor of the survey. (*Id.* at 4.)

Based on the results of the survey, Dr. Sabol opined that there is a “significant” likelihood of confusion between the SMART ONES mark and the SMART BALANCE mark if both marks were to be used for frozen meals. (Sabol Tr. 29:25-30:11, 32:19-33:12.) Dr. Sabol’s survey was also able to measure the level of awareness of the SMART ONES brand. The survey found an 82% aided awareness level of the SMART ONES brand among those survey respondents and potential respondents who had purchased a frozen meal from the frozen food section of a supermarket in the past 30 days. (Sabol Tr. 26:9-27:2 and Ex. 1 at 6-8.) Based on these results, Dr. Sabol concluded that the SMART ONES brand of frozen meals is “extremely well known” and that the data “qualifies SMART ONES as a ‘famous’ brand.” (*Id.* and Ex. 1 at 15.) This conclusion aligns closely with the data that resulted from the Ipsos brand awareness study, which was not commissioned in connection with this proceeding.

The Board does not require surveys in Board proceedings. *See Fort James Operating Co. v. Royal Paper Converting, Inc.*, 83 U.S.P.Q.2d 1624, 1629 (T.T.A.B. 2007). Admittedly, the studies Dr. Sabol has designed and conducted over the years have been largely used for business purposes as opposed to litigation purposes, and by no means is Dr. Sabol a professional litigation witness, inasmuch as only about 5% of his work over the years has been used for litigation. (Sabol Tr. 9:21-10:14.) Even if the Board were to find that Dr. Sabol’s survey is entitled to no weight in the analysis, the *du Pont* factors strongly support a finding of likelihood of confusion in this case. *Cf. Clear Choice Holdings LLC v. Implant Direct Int’l*, Opp. No. 91190485,

TTABVUE Doc. No. 47, at *21, 22-23 (T.T.A.B. Aug. 26 2013) (finding that opposer's survey was flawed and affording it no weight, but finding a likelihood of confusion nonetheless between the marks REAL CHOICE and CLEARCHOICE DENTAL IMPLANTS when used for identical services).

C. Applicant's Proposed SMART BALANCE Trademark Is Likely To Cause Dilution Of Heinz's Famous SMART ONES Mark⁸

Applicant's argument that Heinz has failed to prove its dilution claim turns on the same faulty arguments asserted against Heinz's likelihood of confusion claim. In particular, Applicant argues that there is a "plethora of SMART-branded food products already present in the marketplace" and that the "SMART" portion of Heinz's SMART ONES mark has been rendered weak and descriptive. However, neither of these things is true. Those arguments are refuted above and in Heinz's Trial Brief, and Heinz will spare the Board from repeating the reasons why again, although they apply with equal force to this claim.

Heinz has presented substantial evidence and testimony to prove that it has succeeded in establishing the SMART ONES mark as a household name. Specifically:

- Over its 20-plus year lifespan, Heinz has spent [REDACTED] of dollars to market and promote its SMART ONES mark throughout the United States. From Fiscal Year 2008 to Fiscal Year 2011 alone, Heinz's advertising and marketing expenditures for the SMART ONES brand totaled [REDACTED]. (Gray Conf. Tr. 41-48 and Ex. 40.)

⁸ Should the Board find that Applicant's mark for the applications at issue must be refused registration based on Heinz's likelihood of confusion claim, the Board need not reach Heinz's dilution claim. *See, e.g., Lucasfilm Ltd. v. LoveforPeace Productions*, Opp. No. 91198236, 2013 WL 4758047, at *9 (T.T.A.B. Aug. 23, 2013).

- Heinz sells approximately [REDACTED] SMART ONES products *per year* and the SMART ONES mark appears prominently on each and every SMART ONES product sold, as well as in all of the advertising and marketing materials used to promote the SMART ONES brand and the SMART ONES brand products.
- Heinz's non-litigation consumer studies and Applicant's own market research supports the conclusion that Heinz's SMART ONES mark has achieved a high degree of actual public recognition. Indeed, the *Ipsos* brand awareness study shows an [REDACTED] awareness level of the SMART ONES brand among the general adult population. (Gray Conf. Tr. 63:21-66:8 and Ex. 46.)
- Finally, the record reflects that Heinz owns five registrations for the mark SMART ONES. (Hudson Tr. 19-27 and Exs. 2-6.) The mark has been registered, in each of the five registrations, on the Principal Register as an inherently distinctive mark without resort to Section 2(f) or subject to a disclaimer of any elements of the mark. (*Id.*) Registration is prima facie evidence that a mark is valid. 15 U.S.C. § 1057(b). Furthermore, as the registrations are each more than five years old, they are incontestable and not subject to challenge under Section 2(e). *See* 15 U.S.C. §§ 1065, 1115(b).

Moreover, as set forth in Heinz's Trial Brief, consideration of the enumerated statutory dilution factors weighs in Heinz's favor. There is a high degree of similarity between the parties' marks, such that an association between the marks is likely; Heinz's mark is inherently distinctive; Heinz's use of the SMART ONES mark is substantially exclusive, and Heinz polices unauthorized uses; and the degree of public recognition of Heinz's SMART ONES mark is very high. Of the remaining two factors, one is neutral and one weighs against a finding of dilution;

however, these two factors do not outweigh the four factors strongly in favor of a finding of dilution. In short, Heinz has shown a likelihood of dilution by blurring as to the applications opposed and its oppositions should be sustained on that basis.

IV. CONCLUSION

For the reasons addressed in its Trial Brief and those set forth above, Heinz respectfully reiterates its request that the Board sustain this consolidated opposition proceeding and refuse registration of Applicant's applications.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing was sent by First Class U.S. Mail, postage prepaid, with a courtesy copy via email, on this 26th day of September, 2013, to Counsel for Applicant:

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APPENDIX A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PROMARK BRANDS INC. and
H. J. HEINZ COMPANY,

Opposers,

vs.

GFA BRANDS, INC.,

Applicant.

**Opposition No. 91194974 (Parent)
and Opposition No. 91196358**

U.S. Trademark Application 77/864,305
For the Mark **SMART BALANCE**

U.S. Trademark Application 77/864,268
For the Mark **SMART BALANCE**

REPLY IN SUPPORT OF OPPOSERS' EVIDENTIARY OBJECTIONS

I. ARGUMENT

A. Mr. Johnson's Expert Report And Testimony Should Be Stricken

The Board generously allowed Applicant more than three times as much time as ordinarily permitted under the rules to submit its second rebuttal expert disclosure. However, the second expert report Applicant ultimately disclosed is not styled as a "rebuttal report" at all, and Applicant admits that the Johnson survey is in fact being offered in support of Applicant's case-in-chief. (TTABVue Doc. No. 92 "App. Br." App'x A at 7 n.4 ("GFA never said that it would not use the Johnson survey in its case-in-chief.")) Thus, GFA has acknowledged that the Johnson survey is not a rebuttal report and, in doing so, has acknowledged that that report is many months out of rule. Accordingly, Heinz maintains its objection to the so-called "rebuttal" expert report and testimony of Philip Johnson, in its entirety, as improper rebuttal and respectfully requests that the Board strike and exclude the challenged evidence.

Nowhere in Opposers' Evidentiary Objections do Opposers ProMark Brands Inc. and H. J. Heinz Company (collectively, "Heinz") even suggest that Mr. Johnson's survey was

improperly submitted during the rebuttal trial period in this proceeding. Yet more than half of Applicant's response to Opposers' Evidentiary Objections is spent arguing that Mr. Johnson's survey was not introduced during the rebuttal trial phase. What Heinz contends is that Mr. Johnson was improperly disclosed as a rebuttal expert by Applicant, when in fact Applicant retained Mr. Johnson to provide case-in-chief (as opposed to rebuttal) evidence. Applicant has admitted that Heinz is correct in its contention. (*See, e.g., App. Br. App'x A at 1, 4, 6, 7.*)

A party who wishes to use an expert to support its case-in-chief—regardless of whether the party is in the position of the plaintiff or defendant, or, in this case, opposer or applicant—must “disclose to the other parties the identity of any witness it may use at trial.” Fed. R. Civ. P. 26(a)(2)(A). The disclosure “must be accompanied by a written report.” Fed. R. Civ. P. 26(a)(2)(B). And the disclosure must be made “at the times and in the sequence that the court orders.” Fed. R. Civ. P. 26(a)(2)(D).

1. The Timing And Sequence Of The Johnson Disclosure

Applicant misleadingly asserts that the Board set the expert disclosure deadline for May 1, 2013. When Opposition No. 91194974 was filed, the Board set the “Expert Disclosures” deadline for December 26, 2010. (TTABVUE Doc. No. 2.) After the opposition was consolidated with Opposition No. 91196358 and three extension requests later, the “Expert Disclosures” deadline was reset for January 8, 2012. (TTABVUE Doc. Nos. 21 and 22.) On January 9, 2012 (the actual deadline falling on a Sunday), Heinz timely disclosed Dr. Barry A. Sabol as its expert witness in this proceeding and properly served Dr. Sabol's expert report on Applicant. ***Applicant elected to not make any expert disclosures.***

Because Heinz timely disclosed an expert, Applicant had 30 days after Heinz's disclosure to disclose ***a rebuttal expert***—one whose opinions are “intended ***solely*** to contradict or rebut

evidence on the same subject matter” identified by Heinz’s expert. *See* 37 C.F.R. § 2.120(a)(2); Fed. R. Civ. P. 26(a)(2)(D)(ii); TBMP § 401.03. Accordingly, Applicant’s rebuttal expert disclosure was due by February 8, 2012. Four days before the deadline, Applicant requested a 30-day extension, to which Heinz consented. A stipulation was filed with the Board to that effect, and the 30-day extension was granted. (TTABVUE Doc. Nos. 23 and 24.) About a week before the extended deadline, Applicant indicated that it would not be able to provide its rebuttal expert disclosure until May 1, 2012, and sought Heinz’s approval for the *additional* extension. Heinz refused to consent to such an extension.

In resolving the parties’ dispute over the timing of Applicant’s expert disclosures, the Interlocutory Attorney ordered Applicant “to make its expert disclosures of its first expert and first expert’s report (critique)” by March 21, 2012. (TTABVUE Doc. No. 29 at 4.) Furthermore, the Interlocutory Attorney permitted Applicant to have until May 1, 2012, to disclose its second expert and second expert’s report, based upon certain representations made by Applicant that the content of that report would be ***rebuttal, and not case-in-chief***, evidence. (*See* TTABVUE Doc. No. 29 at 3.) Indeed, the underlying motion granted by the Interlocutory Attorney was styled as Applicant’s “Motion to Extend The Time For ***Rebuttal Expert Disclosures*** And Completion Of Discovery.” (TTABVUE Doc. No. 27, emphasis added.) This is because Applicant had filed a motion to extend the date for the close of *rebuttal expert disclosures*, not “*case-in-chief*” expert disclosures. (*Id.*)

2. *Mr. Johnson’s Report And Testimony Is Both Improper Rebuttal And Inadmissible To Support Applicant’s Case-in-Chief*

Mr. Johnson’s expert report and testimony is inadmissible to support Applicant’s case-in-chief because Applicant failed to timely disclose Mr. Johnson as a case-in-chief expert.

Reference to Mr. Johnson’s report as “rebuttal” evidence is not “mere semantics” (App. Br.

App'x A at 6). Applicant disclosed Mr. Johnson *as a rebuttal expert*. Accordingly, Mr. Johnson's expert report and testimony is admissible "*solely to contradict or rebut*" Dr. Sabol's expert report to the extent such expert report and testimony is relied upon in Heinz's case-in-chief. Fed. R. Civ. P. 26(a)(2)(D)(ii). In other words, Mr. Johnson's survey and testimony must be limited to rebuttal.

As set forth in Opposers' Evidentiary Objections, the Johnson report is entitled, "A Study of Likelihood of Confusion," and is a brand-new, independent survey that has nothing to do with rebutting Dr. Sabol's report (submitted by Heinz nearly four months earlier, in January 2012). The Introduction of Mr. Johnson's report, in which he explains that "[Applicant's] Counsel asked whether I could design and conduct a study that would measure the extent, if any, to which the Smart Balance name that has been objected to by ProMark, is or is not likely to cause confusion when relevant consumers are exposed to it in connection with frozen meal products" (Opposers' Fourth Not. of Reliance Ex. G (Johnson Disc. Dep. Tr. Ex. 2 at ¶5 of Johnson Report)), stands in stark contrast to the opening line of Dr. Kaplan's *true* rebuttal expert report, in which Dr. Kaplan explains that he "was asked by representatives of Quarles & Brady LLP, outside counsel for GFA Brands, Inc., the maker of Smart Balance branded products, *to evaluate a study conducted by Barry A. Sabol, Ph.D.* entitled 'Likelihood of Brand Confusion Between Smart Ones and Smart Balance Resulting from the Introduction of Smart Balance Frozen Meals' (the study)" (Opposers' Third Not. of Reliance Ex. E (Kaplan Disc. Dep. Tr. Ex. 1 at ¶1 of Kaplan Report).) Nowhere in Mr. Johnson's report does he mention Dr. Sabol's expert report or survey. Moreover, Mr. Johnson's report does not indicate that he reviewed, or considered Dr. Sabol's report or survey whatsoever in "design[ing] and conduct[ing]" his own survey.

The Board's decision to overrule the opposer's objection to the survey and testimony of the applicant's expert witness in *AMBEV v. The Coca-Cola Company*, Opp. No. 91178953, 2012 WL 1881492, at *2 (T.T.A.B. May 2, 2012), is inapplicable. In that case, the applicant's expert was identified by the applicant in its rebuttal disclosures as a rebuttal witness. The rebuttal expert in *AMBEV*: (1) critiqued the survey conducted by the opposer's expert; (2) opined as to how the survey should have been conducted; and (3) conducted a rebuttal survey. *Id.* The basis for the opposer's evidentiary objection was only that the rebuttal expert's survey "did not test the same question that was posed in the [opposer's] survey it purports to rebut." *Id.* Here, in contrast, Mr. Johnson's report makes clear that he was not retained by Applicant as a rebuttal expert at all and that Applicant is, again, flagrantly flouting the rules.

Allowing Mr. Johnson's report and testimony to stand would unfairly prejudice Heinz. Of course, the reason both opening expert disclosures and rebuttal expert disclosures are required by the Board is to avoid the use of so-called rebuttal experts to introduce evidence that should have been introduced during a party's case-in-chief. Otherwise, what incentive would any party in the position of the defendant in a proceeding before the Board have to timely disclose a case-in-chief expert when it could simply wait to see if the opposing party discloses an expert and then retain its own case-in-chief expert, and falsely characterize him as a "rebuttal expert." The Board has the authority to strike such reports and/or testimony as beyond the scope of proper rebuttal. *Hard Rock Cafe Int'l (USA) Inc. v. Elsea*, 56 U.S.P.Q.2d 1504 (T.T.A.B. 2000) (sustaining party's objection to so-called rebuttal survey that should have been offered as part of other party's case-in-chief). And that is just what the Board should do here.

B. Dr. Kaplan's and Mr. Johnson's Testimony Beyond The Scope Of Their Expert Reports Should Be Stricken

As set forth above and in Opposers' Evidentiary Objections, nowhere in Mr. Johnson's expert report does he even mention Dr. Sabol's report, much less disclose any opinions about Dr. Sabol's report or survey. Likewise, Mr. Johnson does not mention Dr. Kaplan's report, nor does Mr. Johnson disclose any opinions in his report about Dr. Kaplan's critique. In addition, the testimony elicited from Applicant during Dr. Kaplan's testimony deposition in an effort to bolster Mr. Johnson's survey methodology and results and to discredit Dr. Sabol is improper inasmuch as such opinions were not disclosed in Dr. Kaplan's expert report. Accordingly, Heinz reiterates its objections to the testimony of Dr. Kaplan and Mr. Johnson to the extent that their testimony expresses opinions that are not disclosed in their expert reports, and respectfully requests that the Board strike and exclude the challenged evidence.

Notably, Applicant argues that the omissions from Dr. Kaplan's expert report of Dr. Kaplan's opinions supporting Mr. Johnson's survey and further criticizing Dr. Sabol's survey were substantially harmless and justified. However, Applicant fails to explain how this is so.

As to Mr. Johnson, Applicant argues that, although not disclosed in his expert report, Mr. Johnson's criticisms of Dr. Sabol's report were elicited from Heinz's counsel during Mr. Johnson's discovery deposition and therefore the testimony is not surprising to Heinz. However, the Advisory Committee Notes cited by Applicant in support of that proposition provide only that supplementation of an expert disclosure is not required "when an expert during a deposition corrects information contained in an earlier report." Fed. R. Civ. P. 26, Advisory Committee Note (1993 Am., Sub. (e)). Mr. Johnson's testimony concerning Dr. Sabol's survey was not merely a correction of information contained in Mr. Johnson's report. Mr. Johnson's testimony

concerning Dr. Sabol's survey consisted of entirely new opinions and the basis and reasons therefor, none of which were contained in his expert report.

Applicant also cites "*General Council of the Assemblies of God*, 97 U.S.P.Q.2d at 1861" for the proposition that there is no need to provide a supplemental disclosure of information revealed in a deposition; however, the quoted language does not actually appear in the *General Council* decision. It appears that Applicant intended to cite *Galaxy Metal Gear, Inc. v. Direct Access Technology, Inc.*, 91 U.S.P.Q.2d 1859, 1861 (2009), in which the Board held that the opposer's failure to supplement its *initial disclosures* to include a *particular fact witness* does not preclude the introduction of her discovery deposition at trial. Supplementation of initial disclosures concerning fact witnesses and supplementation of expert disclosures and expert reports concerning an expert witness's opinions and the basis and reasons for those opinions are different matters entirely. The Federal Rules make clear that a party who has made an expert disclosure has a duty to supplement that disclosure to include additions or changes to the information originally disclosed. Fed. R. Civ. P. 26(e)(2). Any supplements must be filed *before the parties' pretrial disclosures* are due. *Id.* If a party fails to disclose information required under Federal Rule 26(a), *that party is prohibited from using any such undisclosed information at trial.* Fed. R. Civ. P. 37(c).

II. CONCLUSION

For the reasons stated above and in Opposers' Evidentiary Objections, Heinz respectfully submits that Mr. Johnson's so-called rebuttal report and testimony, which Applicant now admits is being offered in Applicant's case-in-chief, should be stricken and excluded from consideration by the Board. Moreover, to the extent that Applicant elicited trial testimony from both Dr. Kaplan and Mr. Johnson beyond the scope of the opinions stated in their respective expert

reports, Heinz respectfully submits that such testimony should be stricken and given no consideration by the Board as well.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing was sent by First Class U.S. Mail, postage prepaid, with a courtesy copy via email, on this 26th day of September, 2013, to Counsel for Applicant:

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